



UNITED STATES PATENT AND TRADEMARK OFFICE

cen
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,462	09/30/2003	Andrew Jarabek	PAT 2513-2 US	5556
26123 7590 08/09/2007 BORDEN LADNER GERVAIS LLP WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100 OTTAWA, ON K1P 1J9 CANADA			EXAMINER HAN, CLEMENCE S	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/675,462		JARABEK ET AL.	
	Examiner		Art Unit	
	Clemence Han		2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: There are typographical errors in page 5 line 6. "read access generator 24" and "write access generator 26" should be replaced with "read address generator 24" and "write address generator 26", (See figure 2). Appropriate correction is required.

Claim Objections

2. Claim 25 is objected to because of the following informalities: The period at the end of the claim is missing. Appropriate correction is required.

3. Claim 25-27 are objected to because of the following informalities: There are typographical errors because the claim 25-27 are depending on claim 25. The examiner understood them as depending on the independent claim 24 for the rejection below. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

Art Unit: 2616

of the claimed invention. There is no support for “handling administrative unit (AU-3/AU-4) connection” in the specification. The administrative unit (AU) are found in claim 1, 5 and 16.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 1 and 16, the phrase in the parenthesis’ renders the claim indefinite because it is unclear whether the limitation(s) in the parenthesis are part of the claimed invention or not. For example, see (VT1.5/VT2), (TU11/TU12) and (AU-3/AU-4) in claim 1.

9. Claim 1 recites the limitation "the output" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is unclear because the claim recites “whether to assemble an output ... or handle the output ...” wherein the assembling and the handling are mutually exclusive process depending on the control bit. Therefore, “an output” in line 3 can not be an antecedent basis for “the output” in line 4.

10. Regarding claim 1, the phrase "a state of the control bit" in the last line renders the claim indefinite because it is unclear whether it is the same as “a state of a control bit” in line 2 or not.

Art Unit: 2616

11. Regarding claim 3, the phrase "an STS" in line 2 renders the claim indefinite because it is unclear whether it is the same as "an synchronous transport signal" in claim 1 line 5 or not.

12. Regarding claim 5, the phrase "an AU-3/AU-4" in line 2 renders the claim indefinite because it is unclear whether it is the same as "an synchronous transport signal" in claim 1 line 5 or not.

13. Claim 15 recites the limitation "the second control bit" in line 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 15 recites the limitation "the first control bit" in line 2. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 16 recites the limitation "the output" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is unclear because the claim recites "whether to assemble an output ... or handle the output ..." wherein the assembling and the handling are mutually exclusive process depending on the control bit. Therefore, "an output" in line 6 can not be an antecedent basis for "the output" in line 7.

16. Regarding claim 16, the phrase "a state of the control bit" in the last line renders the claim indefinite because it is unclear whether it is the same as "a state of a control bit" in line 5 or not.

17. Regarding claim 16, the phrase "(AU-3/AU-4)" in line 8 renders the claim indefinite because it is unclear whether it is an acronym for "synchronous transport signal" or not.

Art Unit: 2616

18. Claim 21 recites the limitation "the second control bit" in line 2. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 22 recites the limitation "the second control bit" in line 2. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 23 recites the limitation "the second control bit" in line 3. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 23 recites the limitation "the first control bit" in line 3. There is insufficient antecedent basis for this limitation in the claim.

22. Claim 24 recites the limitation "the output" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is unclear because the claim recites "whether to assemble an output ... or handle the output ..." wherein the assembling and the handling are mutually exclusive process depending on the control bit. Therefore, "an output" in line 3 can not be an antecedent basis for "the output" in line 4.

23. Claim 24 recites the limitation "the state of the control bit" in line 6. There is insufficient antecedent basis for this limitation in the claim.

24. Regarding claim 24, the phrase "a state of the control bit" in line 8 renders the claim indefinite because it is unclear whether it is the same as "the state of the control bit" in line 6 or not.

25. Regarding claim 25, the phrase "an STS" in line 2 renders the claim indefinite because it is unclear whether it is the same as "an synchronous transport signal" in claim 24 line 4 or not.

26. Claim 27 recites the limitation "the memory" in line 1. There is insufficient antecedent basis for this limitation in the claim. There are two memories in claim 24, in line 2 and line 7. It is unclear which memory it is.

Claim Rejections - 35 USC § 102

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

28. Claim 1, 2, 16, 17 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Tsukamoto et al. (US 6,498,794).

Regarding claim 1, 16 and 24, Tsukamoto teaches a method comprising: checking a state of a control bit that specifies whether to assemble an output from multiple virtual tributary (VT1.5/VT2) or tributary unit (TU11/TU12) connections or handle the output as an synchronous transport signal (STS) or administrative unit (AU-3/AU-4) connection; and switching a predetermined number of entries together based on a state of the control bit (Column 6 Line 26-36, Column 7 Line 9-16, see Figure 4).

Regarding claim 2, 17, Tsukamoto teaches the control bit is set by a programmer (Column 7 Line 33-35).

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2616

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claim 3-6, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al..

Regarding claim 3-6, 25 and 26, Tsukamoto teaches a method comprising: checking a state of a control bit that specifies whether to assemble an output from multiple virtual tributary (VT1.5/VT2) or tributary unit (TU11/TU12) connections or handle the output as an synchronous transport signal (STS) or administrative unit (AU-3/AU-4) connection; and switching a predetermined number of entries together based on a state of the control bit (Column 6 Line 26-36, Column 7 Line 9-16, see Figure 4).

Tsukamoto, however, does not teach exact details on how to assemble/handle the output based on whether the control bit is set or not set. It would have been obvious to one skilled in the art to modify Tsukamoto to assemble/handle the output based on whether the control bit is set or not set as claimed in order to accommodate different design choice.

Allowable Subject Matter


31. Claim 7-15, 18-23 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clemence Han whose telephone number is (571) 272-3158. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Clemence Han
Examiner
Art Unit 2616


HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800